

Mintz No. 5075-0043

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**FACSIMILE TRANSMITTAL SHEET**

**TO: Mail Stop Amendment  
USPTO**

**FACSIMILE NO.: (571) 273-8300**

**Group Art Unit 1621**

**FROM: Flavio M. Rose  
Reg. No. 40,791**

**FACSIMILE NO.: (650) 251-7739  
TELEPHONE NO.: (650) 251-7700**

**DATE: November 13, 2006**

**PAGE 1 OF: 5**

**SUBJECT: U.S. Pat. Appl. Ser. No. 10/729,453  
Filed December 4, 2003**

**CONFIRMATION COPY TO FOLLOW:  
☐ YES ☒ NO**

**Entitled "PRECURSORS TO  
FLUOROALKANOL-CONTAINING  
OLEFIN MONOMERS AND  
ASSOCIATED METHODS OF SYNTHESIS  
AND USE"**

**By Gregory BREYTA et al.  
Atty Doc. No. ARC920030074US1**

Please see the attached **Amendment** for the above-identified patent application.

TRA 2221840v.1

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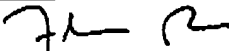
<b>TRANSMITTAL FORM</b> (to be used for all correspondence after initial filing)	Application Number	10/729,453	
	Filing Date	December 4, 2003	
	First Named Inventor	Gregory BREYTA et al.	
	Art Unit	1621	
	Examiner Name	PRICE, Elvis O.	
Mail Stop	Amendment	Attorney Docket Number	ARC920030074US1

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ENCLOSURES (Check all that apply)		
<input checked="" type="checkbox"/> No fee due <input type="checkbox"/> Fee Transmittal <input type="checkbox"/> Fee(s) due <input type="checkbox"/> Fee Transmittal <input type="checkbox"/> Check for \$* <input checked="" type="checkbox"/> Charge any underpayment or credit any overpayment to Deposit Account No. 09-0441 <input type="checkbox"/> Return postcard <input checked="" type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement & Form(s) PTO-1449 <input type="checkbox"/> Copy(ies) of cited reference(s) <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts / Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation, Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s):	<input type="checkbox"/> After Allowance Communication to a Technology Center (TC) <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input type="checkbox"/> Other Enclosure(s) (please identify below):
Remarks: The Commissioner is hereby authorized to charge any additional or underpayment of fee(s) to Deposit Account No. 09-0441.		

## SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual Name (print/type)	Flavio M. Rose, Reg. No. 40,791 Mintz, Levin, Cohn, Ferris, Glovsky and Popeo, P.C.	Telephone	(650) 251-7700
Signature		Date	November 13, 2006

## CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being facsimile transmitted to Examiner Elvis O. Price in Group Art Unit 1621 of the USPTO at facsimile number (671) 273-8300 on the date shown below.			
Name (print/type)	Katherine Stofer	Date	November 13, 2006
Signature		Date	November 13, 2006

Application No. 10/729,453  
Response dated November 13, 2006  
Response to Restriction Requirement dated October 12, 2006

Atty Dkt No. ARC920030074US1  
Mintz No. 5075-0043

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

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In Re Application of:  
Gregory BREYTA et al.

Confirmation No.: 1035

Serial No.: 10/729,453

Group Art Unit: 1621

Filing Date: December 4, 2003

Examiner: PRICE, Elvis O.

Title: PRECURSORS TO FLUOROALKANOL-CONTAINING OLEFIN MONOMERS AND  
ASSOCIATED METHODS OF SYNTHESIS AND USE

**RESPONSE TO REQUIREMENT FOR RESTRICTION**

Mail Stop Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This is in response to the Requirement for Restriction mailed October 12, 2006, in which the Examiner required restriction between I-VIII groups of claims which the Examiner describes as follows:

- (I) Claims 1-14 and 70, drawn to an aliphatic fluorinated polyol, classified in class 568;
- (II) Claims 15-27 and 71, drawn to an aliphatic fluoroalkanol ester, classified in class 560.
- (III) Claims 28-35, 39 and 72, drawn to a cycloaliphatic fluoroalkanol ester, classified in class 560.
- (IV) Claims 36-38, 40-43 and 73, drawn to a fluorodihydroxy ester, classified in class 560.
- (V) Claims 44 and 74, drawn to fluorotrihydroxy ester, classified in class 560.
- (VI) Claims 45-49, drawn to a method for making Group I compounds, classified in class 568.
- (VII) Claims 50-56, drawn to a method for making Group II compounds, classified in class 560.

(VIII) Claims 57-69, drawn to a method for making Groups IV or V compounds, classified in class 560.

In response, applicants elect Group II, claims 15-27 and 71, with traverse.

The restriction requirement is traversed because Groups II, III, IV, V, VII, and VIII are all classified in class 560. Furthermore, Groups II, III, IV, and V all correspond to compositions of matter classified in class 560.

According to the MPEP, a restriction requirement is not permissible unless there would otherwise be a "serious burden" placed on the examiner. MPEP § 803 states:

If the search and examination of all the claims in an application can be made without serious burden, the examiner must examine them on the merits, even though they include claims to independent or distinct inventions.

The Examiner has not explained in any way why the search of claims such as those of groups II and III or IV and V, all classified in class 560, would constitute a burden. Aside from their positions in the patent classification, the close relationship between groups IV and V for search purposes is further shown, for example, by the fact that the Examiner has placed together in Group VIII the claims addressing methods of synthesizing the compounds from both groups IV and V.

For these reasons, it is respectfully be requested that the Examiner withdraw the restriction requirement at least as it pertains to groups II, III, IV, and V, allowing those four groups to be prosecuted together in one application and allowing rejoinder of groups VII and VIII to occur when the conditions for doing so are met.

Applicants expressly reserve their right under 35 USC § 121 to file a divisional application directed to the non-elected subject matter during the pendency of this application.


If the Examiner has any questions concerning this communication, or would like to discuss the application, the art, or other pertinent matters, he is welcome to contact the undersigned attorney at his direct dial (650) 251-7712.

Application No. 10/729,453  
Response dated November 13, 2006  
Response to Restriction Requirement dated October 12, 2006

Atty Dkt No. ARC920030074US1  
Mintz No. 5075-0043

Respectfully submitted,

By:

  
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Date: November 13, 2006

TRA 2220324v.1